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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,913

11/29/2004

Weikert Hendrikus Van Gilst

2578-6485US

7130

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07/26/2006

TRASK BRITT

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EXAMINER

MONDESI, ROBERT B

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/500,913

Applicant(s)

VAN GILST, WEIKERT  
HENDRIKUS

Examiner

Robert B. Mondesi

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1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 5-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to restriction requirement*

Applicants' election with traverse of Invention of Group I, **Claims 1-5** in amendment, filed June 5, 2006 is acknowledged. The traversal is on the ground(s) that WO 01/82952 does not teach EPO, or derivatives or functional analogues thereof, that are produced in a host cell expressing at least the E1A protein of an adenovirus. Accordingly, WO 01/82952 does not show that the special technical feature does not define a contribution over the prior art.

This is not found persuasive because **claim 6** is drawn to a product that is not novel and is taught by the above reference. The mentioned claim is a product by process claim and "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Therefore the requirement is still deemed proper and is made FINAL. **Claims 1-22** are pending in this application. **Claims 6-22** are withdrawn from further consideration because these Claims are drawn to non-elected inventions. **Claims 1-5** are currently under examination.

***Priority***

The current application filed on November 29, 2001 is a 371 of PCT/NL02/00011 filed on January 9, 2003, which in turn claims priority to a foreign application, NETHERLANDS PCT/NL02/00010 filed on January 9, 2002.

***Preliminary Amendment***

The preliminary amendment filed July 8, 2004 has been entered.

***Drawings***

Drawings filed July 8, 2004 have been accepted.

***Information Disclosure Statement***

The IDS filed May 12, 2006 and July 8, 2006 has been received and is signed and considered, a copy of the PTO 1449 is attached to the following document.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-5** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to derivatives or functional analogue thereof of erythropoietin (EPO). The claims do not require that the polypeptide possess any particular conserved structure, or other distinguishing feature, such as a specific biological activity. Thus, the claims are drawn to a genus of polypeptides that is defined by an unclear functional relationship to erythropoietin (EPO). To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, and any combination thereof. In this case, the only factor present in the claim that is sufficiently disclosed is a partial structure in the form of a recitation of percent identity. The specification does not identify any particular portion of the structure that must be characteristics of the claimed genus are not described. The only adequately described species is erythropoietin (EPO) and no active variants are disclosed. Accordingly, the specification does not provide adequate written description of the claimed genus.

*Vas-Cath Inc. v. Mahurkar*, 19USPQ2d 1111, clearly states, "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed." (See page 1117.) The specification does

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not it clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116), As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF' s were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence. Therefore, only erythropoietin, but not the full breadth of the claim meets the written description provision of 35 U. S.C. 112, first paragraph. Applicant is reminded that *Vas-cath* makes clear that the written description provision of 35 U.S.C. § 112 is severable from its enablement provision.

**Claims 1-5** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treatment, does not reasonably provide enablement for prevention. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The factors to be considered in determining whether undue experimentation is required are summarized in *re Wands* 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir.1988). The court in *Wands* states: "Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.'" (*Wands*, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." (*Wands*, 8 USPQ2d 1404). The factors to be considered in determining whether undue experimentation is required include: (1) the breadth of the claims, (2) the nature of the invention, (3) the state of the prior art, (4) the predictability or unpredictability of the art, (5) the relative skill of those in the art, (6) the amount or direction or guidance presented, (7) the presence or absence of working examples, and (8) the quantity of experimentation necessary. Although the quantity of experimentation alone is not dispositive in a determination of whether the required experimentation is undue, this factor does play a central role. For example, a very limited quantity of experimentation may be undue in a fledgling art that is unpredictable where no guidance or working examples are provided in the specification and prior art, whereas the same amount of experimentation may not be undue when viewed in light of some guidance or a working example or the experimentation required is in a predictable established art. Conversely, a large quantity of experimentation would require a

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correspondingly greater quantum of guidance, predictability and skill in the art to overcome classification as undue experimentation. In *Wands*, the determination that undue experimentation was not required to make the claimed invention was based primarily on the nature of the art, and the probability that the required experimentation would result in successfully obtaining the claimed invention. (*Wands*, 8 USPQ2d 1406). Thus, a combination of factors which, when viewed together, would provide an artisan of ordinary skill in the art with an expectation of successfully obtaining the claimed invention with additional experimentation would preclude the classification of that experimentation as undue. A combination of *Wands* factors, which provide a very low likelihood of successfully obtaining the claimed invention with additional experimentation, however, would render the additional experimentation undue.

1-2. Breadth of the claims and the nature of the invention..

The invention is a method of treating a patient suffering from, or at risk of suffering from a chronic coronary syndrome, the method comprising: producing erythropoietin (EPO), or derivative or functional analogue thereof, in a host cell expressing at least the EIA protein of an adenovirus; preparing a medicament comprising said EPO, or derivative or functional analogue thereof, for the preventive and/or curative treatment of a patient suffering from, or at risk of suffering from a chronic coronary syndrome; and administering said medicament to said patient.

3-4. The state of prior art and the level of predictability in the art.



In regards to the treatment of coronary syndrome, Brines et al. provide evidence for the treatment of coronary syndrome using erythropoietin. However, a method of prevention of coronary syndrome is not disclosed in the previous studies of such topic.

Since there is not much known about the nature of preventing coronary syndrome, the level of predictability in the art is low with regards to administering erythropoietin for the prevention of coronary syndrome and therefore the specification would need to provide more information as to how to make and use the invention.

5. The relative skill in the art.

The relative skill in the art as it relates to the method of the invention is characterized by that of a M.D. or Ph. D. level individual.

6-7. The amount of guidance present and the existence of working examples.

The applicants have not provided any guidance for the prevention of coronary heart disease comprising the administering of erythropoietin. The applicants have only provided guidance as to how the administering of erythropoietin can be used to treat coronary heart disease.

The specification on pages 9-16 provides examples of how erythropoietin can be used for the treatment of coronary syndrome. However, the specification does not provide any information or examples that would suggest that the applicant's invention could be used to prevent coronary syndrome.

8. The quantity of experimentation necessary.

The amount of experimentation that is required is undue: while treatment of coronary syndrome is routine, prevention of coronary syndrome is not routine and

requires more experimentation. Therefore, in view of the overly broad scope of the claims, the lack of guidance and working examples provided in the specification, and the high degree of unpredictability as evidenced by the prior art, undue experimentation would be necessary for a skilled artisan to make and use the entire scope of the claimed invention.

It must be noted that the issue in this case is the breath of the claims in light of the predictability of the art as determined by the number of working examples, the skill level of the artisan and the guidance presented in the instant specification and the prior art of record. The Applicants make and test position is inconsistent with the decisions of *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) where it is stated that "... scope of claims must bear a reasonable correlation to scope of enablement provided by the specification to persons of ordinary skill in the art...". Without sufficient guidance, determination of having the desired biological characteristics is unpredictable and the experimentation left to those skilled in the art is unnecessarily and improperly extensive and undue. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). Therefore, for the instant specification to be enabling, it needs to provide direction/guidance a method of prevention of coronary syndrome comprising the administering of erythropoietin.

Absent sufficient guidance/direction one of skill in the art would not be able to practice the claimed invention commensurate in scope with the claims. Thus, for all these reasons, the specification is not considered to be enabling for one skilled in the art to make and use the claimed invention as the amount of experimentation required is

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undue, due to the broad scope of the claims, the lack of guidance and insufficient working examples provided in the specification and the high degree of unpredictability as evidenced by the state of the prior art, attempting to develop a method of prevention as encompassed by the claimed invention would constitute undue experimentation. Therefore, applicants have not provided sufficient guidance to enable one of skill in the art to make and use the claimed invention in a manner that reasonably correlates with the scope of the claims, to be considered enabling.

**Claims 1-5** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **claim 1** E1A needs to be spelled out in the first instance of use.

In **claim 2** PER needs to be spelled out in the first instance of use, furthermore in claim 2 there appears to be a period after PER, the placement of the period effectively finishes the claims. The mentioned period needs to be deleted, if applicants wish the phrase "C6 cell" to be included in the claim. Furthermore PER.C6 is a trademark and can not be included in the claim accordingly where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe

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the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a cell line and, accordingly, the identification/description is indefinite.

**Claims 3-5** are dependent claims that do remedy the deficiencies of the claim that they are dependent therefrom.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brines et al., US Patent No. 6,531,121 in view of Berg et al. US Patent No. 5, 506,118.

Brines et al. teach a method of treating a patient suffering from chronic coronary syndrome, wherein the coronary syndrome is cardiac failure or chronic ischemia and the

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patient is non-anemic comprising administering a medicament comprising erythropoietin, wherein the erythropoietin is recombinantly produced (column 1, lines 65-68 through column 2, lines 1-3; column 3, line 26-27; column 4, lines 13-25, column 10, lines 37, column 18, lines 7-12, Example 3, column 19, lines 23-36).

Brines et al. do not teach that the said erythropoietin was produced in a host cell expressing at least the E1A protein of adenovirus.

Berg et al. teach that the E1A gene product is used in cells to enhance expression activity (Abstract and column 4, lines 7-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the EA1 protein for the advantages of increasing cellular protein expression as taught by Brines et al. and Berg et al., see Berg et al. at column 4 lines 7-13.

### ***Conclusion***

No claims are allowed.

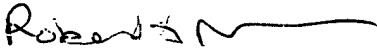
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Mondesi whose telephone number is 571-272-0956. The examiner can normally be reached on 9am-5pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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7-20-06